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EXAMINER

CLARK, AMY LYNN

ART UNIT	PAPER NUMBER
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1655

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/28/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/28/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/529,860

Applicant(s)

OHNOGI ET AL.

Examiner

Amy L. Clark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 7-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 6 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/26/2006
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the receipt and entry of the amendment filed on 26 December 2006 with the amendment of claim 5 and the addition of newly added Claims 14-18.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

Newly submitted claims 14 and 15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The original invention was drawn "A food, beverage or feed for promotion of osteogenesis or enhancement of bone morphogenetic protein production, characterized in that the food, beverage or feed comprises a processed product derived from a plant selected from the following (a) to (c):

- (a) a processed product derived from a plant belonging to Umbelliferae;
- (b) a processed product derived from a plant belonging to Liliaceae;
- (c) a processed product derived from a plant belonging to Compositae. Newly submitted claim 14 is drawn to "A method of enhancing bone morphogenetic protein production, which comprises: administering to an individual a food, drink or feed comprising a processed product derived from at least one plant selected from the group consisting of: (a) a plant belonging to Umbelliferae; (b) a plant belonging to Liliaceae; and (c) a plant belonging to Compositae, wherein the processed product is at least one

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product selected from the group consisting of an extract, a powder, a squeezed juice, a pulverized product, a chemically processed product and an enzymatically processed product" and newly submitted claim 15 is drawn to "The method according to claim 14, wherein the extract is a water extract."

The Invention of claim 5 and the Invention of newly added claims 14 and 15 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product as claimed can be used in a materially different process of using that product. For example, the product as claimed can be used to lower blood cholesterol and blood pressure.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14 and 15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-18 are currently pending.

This application contains claims 1-4 and 7-15, which are drawn to an invention nonelected with traverse in "Response to Election / Restriction Filed", which was filed on 14 August 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 5, 6 and 16-18 are under examination.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 26 December 2006 was considered. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

Claim 5 is objected to because of the following informalities: The phrase "characterized in that the food, beverage or feed comprises a water extract derived from at least one plant selected from the group consisting of" from lines 2-4 should be amended to read, "~~characterized in that~~ wherein the food, beverage or feed comprises a ~~water extract derived from~~ at least one plant selected from the group consisting of (please amend to indicate what Applicant means by "water extract"- See 112 2nd paragraph rejection below). Appropriate correction is required.

Claim Rejections - 35 USC § 112

Applicant's arguments, see "Applicant Arguments/Remarks Made in an Amendment", filed 26 December 2006, with respect to the rejection(s) of claim(s) 5 and 6 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, wherein the metes and bounds of Claim 5 are rendered uncertain by the phrase "the food, beverage or feed comprises a processed product derived from a plant" because it is unclear as to what "a processed product derived from a plant" is. "A processed product derived from a plant" could be an extract, a powder, a protein, a bioactive compound, etc. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The metes and bounds of Claims 5 and 16-18 are rendered uncertain by the phrase "A food, beverage or feed characterized in that the food, beverage or feed comprises a water extract derived from at least one plant selected from the following: (a) a plant belonging to Umbelliferae; (b) a plant belonging to Liliaceae; and (c) a plant belonging to Compositae" in claim 5 and "The food, beverage or feed according to claim

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5, wherein the water extract is derived from a plant" in claims 16-18 because it is unclear what Applicant means by a water extract derived from at least one plant. Does Applicant mean that a plant is extracted with water to obtain an aqueous extract or does Applicant meant that water itself is extracted from a plant? The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired. Newly applied as necessitated by amendment.

Response to Arguments

Claim Rejections - 35 USC § 102

Applicant's arguments, see "Applicant Arguments/Remarks Made in an Amendment", filed 26 December 2006, with respect to the rejection(s) of claim(s) 5 and 6 under 35 U.S.C. 102(b) as being anticipated by Okukawa (N*, JP 2001-178407) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made under 35 U.S.C. 102(b), wherein newly amended claim 5 and newly added claims 16-18 are anticipated by http://web.archive.org/web/*/http://www.recipeland.com//leek-and-artichoke_soup.html (U), and wherein newly amended Claim 5, Claim 6 and newly added claims 16 and 17 are newly rejected under 35 U.S.C. 102(b) as being anticipated by Thomas (V). A new grounds of rejection of Claims 5, 6 and 16-18 is also made below under 35 U.S.C. 103(a) as being unpatentable over http://web.archive.org/web/*/http://www.recipeland.com//leek-and-artichoke_soup.html (U), in view of Thomas (V).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Newly amended Claim 5 and newly added claims 16-18 are newly rejected under 35 U.S.C. 102(b) as being anticipated by

http://web.archive.org/web/*/http://www.recipeland.com//leek-and-artichoke_soup.html

(U). Newly applied as necessitated by amendment.

http://web.archive.org/web/*/http://www.recipeland.com//leek-and-artichoke_soup.html teaches leek and artichoke soup (which is defined as “liquid food”)

which comprises artichoke, leek, parsley, garlic and lettuce.

http://web.archive.org/web/*/http://www.recipeland.com//leek-and-artichoke_soup.html

further teaches that the artichoke (a plant belonging to Compositae), leek (a plant belonging to Liliaceae), parsley (a plant belonging to Umbelliferae), garlic (a plant belonging to Liliaceae) and lettuce (a plant belonging to Compositae) are stewed in water, which reads on a food, beverage or feed characterized in that the food, beverage or feed comprises a water extract derived from at least one plant selected from the following: (a) a plant belonging to Umbelliferae; (b) a plant belonging to Liliaceae; and (c) a plant belonging to Compositae.

It is noted that the reference does not teach that the composition can be used in the manner instantly claimed, however, the intended use of the claimed composition

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does not patentably distinguish the composition, *per se*, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency and product-by-process claims.

Therefore, the reference anticipates the claimed subject matter.

Newly amended claim 5, claim 6 and newly added claims 16 and 17 are newly rejected under 35 U.S.C. 102(b) as being anticipated by Thomas (V). Newly applied as necessitated by amendment.

Thomas teaches vegetable broth I (which is synonymous with soup) comprising celery (a plant belonging to Umbelliferae and of the genus *Apium*), onions (a plant belonging to Liliaceae), carrots (a plant belonging to Umbelliferae), parsley (a plant belonging to Umbelliferae) and garlic (a plant belonging to Liliaceae), wherein the celery, onions, carrots, parsley and garlic are boiled in water and strained to provide a

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liquid vegetable broth (See page 57, column 1), which reads on a food, beverage or feed characterized in that the food, beverage or feed comprises a water extract derived from at least one plant selected from the following: (a) a plant belonging to Umbelliferae; (b) a plant belonging to Liliaceae; and (c) a plant belonging to Compositae.

It is noted that the reference does not teach that the composition can be used in the manner instantly claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, *per se*, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency and product-by-process claims.

Therefore, the reference anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5, 6 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over http://web.archive.org/web/*/http://www.recipelands.com//leek-and-artichoke_soup.html (U), in view of Thomas (V).

The teachings of http://web.archive.org/web/*/http://www.recipelands.com//leek-and-artichoke_soup.html are set forth above and applied as before.

The teachings of Thomas are set forth above and applied as before. Thomas further teaches that the vegetable broth can be used as stock in the making of other soups.

The teachings of http://web.archive.org/web/*/http://www.recipeland.com//leek-and-artichoke_soup.html and Thomas are set forth above.

http://web.archive.org/web/*/http://www.recipeland.com//leek-and-artichoke_soup.html

does not teach a food, beverage or feed comprising a water extract of *Apium*. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art and one would have been motivated and had a reasonable expectation of success to modify the composition taught by

http://web.archive.org/web/*/http://www.recipeland.com//leek-and-artichoke_soup.html

to provide the instantly claimed invention because at the time the invention was made, a soup comprising artichoke (a plant belonging to Compositae), leek (a plant belonging to Liliaceae), parsley (a plant belonging to Umbelliferae), garlic (a plant belonging to Liliaceae) and lettuce (a plant belonging to Compositae), which reads on a food, beverage or feed characterized in that the food, beverage or feed comprises a water extract derived from at least one plant selected from the following: (a) a plant belonging to Umbelliferae; (b) a plant belonging to Liliaceae; and (c) a plant belonging to Compositae was known, as clearly taught by

http://web.archive.org/web/*/http://www.recipeland.com//leek-and-artichoke_soup.html,

as was a soup comprising celery (a plant belonging to Umbelliferae and of the genus *Apium*), onions (a plant belonging to Liliaceae), carrots (a plant belonging to Umbelliferae), parsley (a plant belonging to Umbelliferae) and garlic (a plant belonging to Liliaceae), which reads on a food, beverage or feed characterized in that the food, beverage or feed comprises a water extract derived from at least one plant selected

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from the following: (a) a plant belonging to Umbelliferae; (b) a plant belonging to Liliaceae; and (c) a plant belonging to Compositae, as clearly taught by Thomas.

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since

http://web.archive.org/web/*/http://www.recipelands.com/leek-and-artichoke_soup.html

teaches that soup may be made with artichoke (a plant belonging to Compositae), leek (a plant belonging to Liliaceae), parsley (a plant belonging to Umbelliferae), garlic (a plant belonging to Liliaceae) and lettuce (a plant belonging to Compositae), and since Thomas teaches that soup may be made with celery (a plant belonging to Umbelliferae and of the genus *Apium*), onions (a plant belonging to Liliaceae), carrots (a plant belonging to Umbelliferae), parsley (a plant belonging to Umbelliferae) and garlic (a plant belonging to Liliaceae), it would have been obvious to combine these plants with the expectation that such a combination would be effective in skin care compositions. Thus, combining them flows logically from their having been individually taught in prior art.

No claims are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy L. Clark
AU 1655

Amy L. Clark
March 14, 2007


MICHELE FLOOD
PRIMARY EXAMINER